

REMARKS

First, it should be noted that Claims 1-19 are currently pending. In the Official Action mailed on June 26, 2007, however, only Claims 1-8 were examined. The most recent claim set appears in the Preliminary Amendment filed on July 22, 2005.

Claims 1-8 have been rejected under 35 U.S.C. §102(e)¹ as allegedly being anticipated by U.S. Patent No. 6,908,722 to Ebata et al. (hereinafter referred to as “Ebata”). This rejection is respectfully traversed.

The above rejection relies upon the disclosure in Ebata of the compound 1-(4-n-butoxynaphthalen-1-yl) tetrahydrothiophenium nonafluoro-n-butanesulfonate and the use of this compound as a photoacid generator in a photoresist composition (page 3 of the Official Action). The present application and Ebata have two common inventors (i.e., Satoshi Ebata and Yong Wang). Submitted herewith is a declaration attributing the disclosures in the Ebata reference that were relied upon in the Official Action to Satoshi Ebata and Yong Wang (i.e., the common inventors). As set forth in the MPEP, an applicant’s disclosure of his or her own work within the year before the application filing date cannot be used against him or her under 35 U.S.C. §102(e). MPEP §2136.05. Thus, an applicant may overcome a rejection under 35 U.S.C. §102(e) by submitting a specific declaration establishing that the patent or patent publication is describing the applicant’s own previous work. Ibid. Accordingly, it is respectfully submitted that Claims 1-8 are

¹ The Official Action refers to a rejection under 35 U.S.C. §102(b) in numbered paragraph 2. However, only the text for 35 U.S.C. §102(e) is reproduced in the first paragraph of the rejection (i.e., numbered paragraph 1 of the Official Action). In addition, Ebata issued on June 21, 2005 which is after the filing date of the present application (i.e., June 9, 2004) and is therefore unavailable as a reference under 35 U.S.C. §102(b).

patentable over the Ebata reference. Reconsideration and withdrawal of this rejection is therefore respectfully requested.

Claims 1 and 3-8 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,187,504² to Suwa et al. (hereinafter referred to as “Suwa”). This rejection is respectfully traversed.

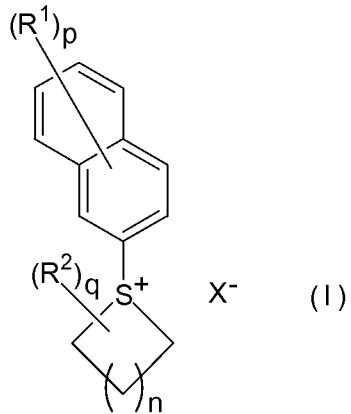
The Official Action is relying upon the disclosure in Suwa of various acid generator compounds (page 4 of the Official Action). These compounds are set forth below along with the chemical structure of each compound. Also provided are the substituent definitions corresponding to formula (I) of Claim 1.

Chemical Name and Structure
4-hydroxy-1-naphthyltetrahydrothiophenium trifluoromethanesulfonate
4-methoxy-1-naphthyltetrahydrothiophenium trifluoromethanesulfonate

² The Official Action uses the incorrect patent number for Suwa.

Chemical Name and Structure
<p>4-n-butoxy-1-naphthyltetrahydrothiophenium trifluoromethanesulfonate</p>
<p>4-t-butoxy-1-naphthyltetrahydrothiophenium trifluoromethanesulfonate</p>
<p>4-n-butoxy-1-naphthyltetrahydrothiophenium nonafluorobutanesulfonate</p>

As can be seen from the above Table, in each of the above compounds the thiophene ring is bonded to the 1-position of the napthyl group. Claim 1, however, recites a sulfonium salt compound of the following formula:



Accordingly, for the sulfonium salt compounds of present formula (I), the thiophene ring is bonded to the 2 position of the naphthyl group. It is respectfully submitted that none of the compounds disclosed in Suwa and relied upon in the Official Action meet the definition of formula (I) of present Claim 1. It is therefore respectfully submitted that Claim 1 is not anticipated by Suwa. Claims 3-8 depend either directly or indirectly from Claim 1 and are therefore also not anticipated by Suwa for at least the reasons set forth above with respect to Claim 1. Reconsideration and withdrawal of this rejection is therefore respectfully requested.

Claims 1-8 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Ebata or Suwa. This rejection is respectfully traversed.

As set forth above, Ebata is available as a reference under 35 U.S.C. §102(e). As set forth in the attached “Statement of Common Ownership”, the Ebata reference and the present application were, at the time the invention defined by the present claims was

made, owned by or subject to an obligation of assignment to JSR Corporation.

Accordingly, the Ebata reference is disqualified as prior art under 35 U.S.C. §103(c) {see MPEP §706.02(l)(1)}.

As also set forth above, none of the compounds disclosed in Suwa and relied upon in the Official Action are sulfonium salt compounds as set forth in formula (I) of present Claim 1 wherein the thiophene ring is bonded to the 2 position of the naphthyl group.

In view of the above, reconsideration and withdrawal of this rejection is therefore respectfully requested.

Claim 20 has been added. Claim 20 encompasses the subject matter of original Claim 1 wherein q is 0. It is respectfully submitted that Claim 20 is patentable over the cited references. In particular, all of the acid generator compounds disclosed in Suwa and relied upon in the Official Action have substituted thiophene groups.

CONCLUSION

In view of the above amendments and remarks, Applicants respectfully request a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

MERCHANT & GOULD P.C.

October 1, 2007

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